

1
2
3
4
5
6
7
8 **UNITED STATES DISTRICT COURT**
9 **SOUTHERN DISTRICT OF CALIFORNIA**
10

11 KEEP A BREAST FOUNDATION,
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Plaintiff,

vs.

THE SEVEN GROUP, et al.,
Defendants.

CASE NO. 11-cv-00570 BEN (WMC)

ORDER:

**(1) GRANTING IN PART
DEFENDANTS' PARTIAL
MOTION TO DISMISS**

**(2) DENYING DEFENDANTS'
MOTION FOR A MORE
DEFINITE STATEMENT**

[Docket No. 6]

Presently before the Court is Defendants Adam Shryock and Pure Savings, LLC's Partial Motion to Dismiss the Complaint or, in the Alternative, Motion for a More Definite Statement. (Docket No. 6.) For the reasons set forth below, the Court **GRANTS IN PART** Defendants' Partial Motion to Dismiss. The second claim is dismissed without prejudice, and the sixth claim remains. The Court **DENIES** Defendants' Motion for a More Definite Statement.

BACKGROUND

Plaintiff Keep a Breast Foundation is a non-profit organization. (Compl. ¶ 1.) Plaintiff owns the "Keep a Breast" trademark (Reg. No. 3148275) and the "Heart & Breasts" trademark (Reg. No. 3870574). (*Id.* ¶ 18.) Plaintiff also has pending three federal trademark applications for the "Heart & Breast" design, two federal trademark applications for the "I Love Boobies" word mark, and several federal trademark applications for various designs of "I (Heart) Boobies." (*Id.*) Plaintiff sells goods

1 bearing these trademarks at various retail locations throughout the United States and on Plaintiff's
2 website. (*Id.* ¶ 22.)

3 Plaintiff alleges that "Defendants have offered for sale, continue to offer for sale, and sell
4 apparel products and accessories that bear confusingly similar imitations of the Plaintiff's registered
5 HEART & BREASTS ® design trademark, the I LOVE BOOBIES! trademark applications, and I
6 (HEART) BOOBIES design trademark applications." (*Id.* ¶ 3.) In addition, Plaintiff alleges that
7 "Defendants have adopted the overall look and feel of products being sold bearing [Plaintiff's]
8 Trademarks." (*Id.* ¶ 5.) "Defendants' merchandise is likely to cause confusion and to deceive
9 consumers and the public regarding its source and dilutes and tarnishes the distinctive quality of
10 Plaintiff's trademarks and trade dress." (*Id.* ¶ 3.)

11 On March 22, 2011, Plaintiff filed a complaint, which alleged: (1) federal trademark
12 infringement under 15 U.S.C. § 1114; (2) federal trade dress infringement under 15 U.S.C. § 1125(a);
13 (3) federal trademark dilution under 15 U.S.C. § 1125(c); (4) unfair competition under the Lanham
14 Act, 15 U.S.C. § 1125(a); (5) trademark dilution under California law; (6) California Unfair
15 Competition violations; (7) unjust enrichment; and (8) individual liability piercing the corporate veil
16 (alter ego, failure to observe corporate formalities, commingling assets, and inadequate capitalization).
17 Presently before the Court is Defendants Adam Shryock and Pure Savings, LLC's Partial Motion to
18 Dismiss the Complaint or, in the Alternative, Motion for a More Definite Statement. Being fully
19 briefed, the Court finds the Motion suitable for determination on the papers without oral argument,
20 pursuant to Civil Local Rule 7.1.d.1.

21 DISCUSSION

22 I. MOTION TO DISMISS

23 Under Federal Rule of Civil Procedure 12(b)(6), dismissal is appropriate if, taking all factual
24 allegations as true, the complaint fails to state a plausible claim for relief on its face. FED. R. CIV. P.
25 12(b)(6); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556–57 (2007). Under this standard, dismissal
26 is appropriate if the complaint fails to state enough facts to raise a reasonable expectation that
27 discovery will reveal evidence of the matter complained of, or if the complaint lacks a cognizable legal
28 theory under which relief may be granted. *Id.* at 556.

1 Defendants move to dismiss the second and sixth claims. Each of these claims will be
2 addressed in turn.

3 **A. Second Claim: Federal Trade Dress Infringement Under 15 U.S.C.**
4 **§ 1125(a)**

5 In its second claim, Plaintiff alleges that “Defendants manufacture, distribute, advertise, offer
6 for sale, and/or sell apparel product and accessories with a trade dress that is identical or substantially
7 similar to the Plaintiff’s trade dress,” in violation of the Lanham Act § 43(a), 15 U.S.C. § 1125(a).
8 (Compl. ¶¶ 61–63.) Plaintiff argues that the trade dress infringement claim should be dismissed
9 because Plaintiff fails to plead the elements of the claim with specificity.

10 “[T]rade dress involves the total image of a product and may include features such as size,
11 shape, color, color combinations, texture, or graphics.” *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d
12 609, 613 (9th Cir. 1989) (internal quotation marks omitted). To state a claim for trade dress
13 infringement under § 43 of the Lanham Act, one must allege that the trade dress is (1) nonfunctional,
14 (2) either “inherently distinctive or [has] acquired distinctiveness through a secondary meaning,” and
15 (3) likely to be confused with Defendants’ products by the consuming public. *Disc Golf Ass’n, Inc.*
16 *v. Champion Discs, Inc.*, 158 F.3d 1002, 1005 (9th Cir. 1998).

17 “A plaintiff should clearly articulate its claimed trade dress to give a defendant sufficient
18 notice.” *Sleep Sci. Partners v. Lieberman*, 2010 WL 1881770, at *3 (N.D. Cal. May 10, 2010). Here,
19 Plaintiff alleges only that “the Defendants have adopted the overall look and feel of products being
20 sold bearing [Plaintiff’s] Trademarks.” (Compl. ¶ 5.) Plaintiff does not describe, or even list, the
21 elements that compose the “overall look and feel” of their products. Defendants have not been
22 sufficiently put on notice of the trade dress at issue. *Cf. Sleep Sci. Partners*, 2010 WL 1881770, at *3
23 (finding that the plaintiff did not provide “an adequate definition of the elements comprising the
24 website’s ‘look and feel,’” because “[a]lthough it has cataloged several components of its website,
25 Plaintiff has not clearly articulated which of them constitute its purported trade dress”); *Autodesk, Inc.*
26 *v. Dassault Sys. SolidWorks Corp.*, 2008 WL 6742224, at *5 (N.D. Cal. Dec. 18, 2008) (finding that
27 the defendant “must provide more detail and clarify the total appearance of the product that [the
28 defendant] claims is the trade dress at issue”).

1 Plaintiff argues that it has sufficiently identified its proposed trade dress, pointing to the
 2 allegation that “the Defendants have adopted the overall look and feel of products being sold bearing
 3 [Plaintiff’s] Trademarks.” (Compl. ¶ 5.) Plaintiff cites *Blue Bell Bio-Med. v. Cin-Bad, Inc.*, 864 F.2d
 4 1253, 1256 (5th Cir. 1989), for the proposition that “[a] product’s overall ‘look and feel’ has been held
 5 to constitute trade dress.” (Pl. Opp. at 4–5.). It is true that a product’s overall “look and feel” can
 6 constitute trade dress. *Blue Bell Bio-Med.*, 864 F.2d at 1256. That “look and feel” can constitute trade
 7 dress, however, does not address the required specificity with which a product’s “look and feel” must
 8 be alleged.

9 Because the Court finds that Plaintiff has not sufficiently described its proposed trade dress,
 10 it need not reach whether Plaintiff sufficiently pled the elements of likelihood of confusion or
 11 distinctiveness/secondary meaning. Accordingly, Defendants’ motion to dismiss the second claim is
 12 **GRANTED**. The second claim is dismissed without prejudice.

13 **B. Sixth Claim: California Unfair Competition Violations**

14 In its sixth claim, Plaintiff alleges that “Defendants’ intentional acts of trademark and trade
 15 dress infringement are unlawful, deceptive, and/or unfair business acts and/or practices that constitute
 16 unfair competition under California state law,” including California Business & Professions Code
 17 §§ 17200 *et seq.* (Compl. ¶¶ 86, 87.) In addition, Plaintiff alleges that “Defendants’ unlawful, unfair,
 18 deceptive, and fraudulent business practices and unfair, deceptive, untrue, and misleading advertising
 19 constitute despicable, outrageous, oppressive, and malicious conduct under California Civil Code
 20 § 3294.” (*Id.* ¶ 93.)

21 Defendants argue that “[s]ince the California state unfair competition claim is predicated on
 22 Plaintiff’s Federal Trademark Infringement and Federal trade Dress claims, the California state unfair
 23 competition [claim] is preempted.” (Def. Mot. at 6.) Plaintiff’s trade dress claim has been dismissed
 24 without prejudice, as explained above. The issue, therefore, is whether the California unfair
 25 competition claim may be predicated on the federal trademark infringement claim brought under the
 26 Lanham Act.

27 The Court finds that there is not sufficient authority that the Lanham Act preempts claims
 28 brought under California unfair competition law, as “the Lanham Act does not in general preclude state

1 unfair competition statutes from operating.” *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 41 (1st Cir.
 2 2006); *see also Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 373 (5th Cir. 1980) (explaining that
 3 the Lanham Act “is cumulative of, and does not preempt, the broader consumer-oriented remedies
 4 provided by the common law of unfair competition”), *abrogated on other grounds by Two Pesos, Inc.*
 5 *v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

6 In support of the proposition that the California unfair competition claim is preempted by the
 7 Lanham Act, Plaintiff cites *Kodadek v. MTV Networks, Inc.*, 152 F.3d 1209, 1212 (9th Cir. 1998),
 8 *Experexchange, Inc. v. Doculex, Inc.*, 2009 WL 3837275, at *24 (N.D. Cal. Nov. 16, 2009), and
 9 *Capcom Co., Ltd. v. MKR Group, Inc.*, 2008 WL 4661479, at *15 n.10 (N.D. Cal. Oct. 20, 2008).
 10 *Kodadek* and *Experexchange*, however, hold that California unfair competition claims are preempted
 11 by the Copyright Act, not the Lanham Act. *See Kodadek*, 152 F.3d at 1212 (“A state law cause of
 12 action is preempted by the *Copyright Act* if two elements are present. First, the rights that a plaintiff
 13 asserts under state law must be rights that are equivalent to those protected by the Copyright Act.
 14 Second, the work involved must fall within the subject matter of the Copyright Act as set forth in 17
 15 U.S.C. §§ 102 and 103.” (emphasis added) (internal quotation marks and citations omitted));
 16 *Experexchange*, 2009 WL 3837275, at *24 (explaining that although the defendants argued that the
 17 plaintiff’s claims were preempted by both the Copyright Act and the Lanham Act, because “the Court
 18 finds that the state law claims are preempted by the *Copyright Act*, it need not reach the question of
 19 preemption under the *Lanham Act*” (emphasis added)).

20 Plaintiff’s reliance on *Capcom* is similarly unconvincing. *Capcom* is an unpublished opinion
 21 from outside this district. In *Capcom*, the court discussed whether the defendant’s California unfair
 22 competition counterclaim was preempted by either the Copyright Act or the Lanham Act in a footnote.
 23 The court noted that “[the defendant] does not differentiate under what legal theory it is pursuing the
 24 two remaining counterclaims (under copyright or trademark law).” *Capcom*, 2008 WL 4661479, at
 25 *15 n.10. The court concluded that whether the defendant were pursuing the counterclaim under either
 26 the Copyright Act or the Lanham Act, the result would be the same: The counterclaim would be
 27 preempted because “there are no new facts pled under either legal theory as [the defendant] merely
 28 incorporates all previous facts.” *Id.* In support of its finding that the counterclaim was preempted by

1 the Lanham Act, the court cited only *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d
 2 1434, 1439, 1441 (9th Cir. 1993). *Summit*, however, held that the plaintiff's California
 3 misappropriation claim was preempted by federal *patent law*. *Id.* Taken as a whole, *Capcom* does not
 4 sufficiently support the proposition that the California unfair competition claim is preempted by the
 5 Lanham Act.

6 The Court declines to find that Plaintiff's California unfair competition claim is preempted by
 7 the Lanham Act. Defendants' motion to dismiss the sixth claim is **DENIED**.

8 **II. ALTERNATIVE MOTION FOR A MORE DEFINITE STATEMENT**

9 Defendants argue that if the Court denies any part of their motion to dismiss, it should order
 10 Plaintiff to provide a more definite statement. In regards to the second claim, Defendants' alternative
 11 motion will not be addressed because the Court grants the motion to dismiss as to this claim, as
 12 discussed above. In regards to the sixth claim, Defendants request that the Court "order the Plaintiff
 13 to provide a more definite statement of the specific wrongful acts supporting that claim." (Def. Mot.
 14 at 7.) As explained above, the Court denies Defendants' motion to dismiss the sixth claim because
 15 there is insufficient legal authority to support the proposition that the Lanham Act preempts California
 16 unfair competition claims. This does not concern whether Plaintiff provided sufficient facts in support
 17 of its claim. Accordingly, Defendants' motion for a more definite statement is **DENIED**.


18 **CONCLUSION**

19 For the reasons stated above, the Court **GRANTS IN PART** Defendants' Partial Motion to
 20 Dismiss. The second claim is dismissed without prejudice, and the sixth claim remains. Plaintiff is
 21 **GRANTED** forty-five (45) days from the date of this Order to file a First Amended Complaint.

22 The Court **DENIES** Defendants' Motion for a More Definite Statement.

23
 24 **IT IS SO ORDERED.**

25
 26 DATED: July 28, 2011

27 
 28 HON. ROGER T. BENITEZ
 United States District Court Judge